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EXAMINER

LY, NGHI H

ART UNIT	PAPER NUMBER
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2683

DATE MAILED: 06/04/2003

12

Please find below and/or attached an Office communication concerning this application or proceeding.

7

Office Action Summary

Application No.

09/447,284

Applicant(s)

CAO ET AL.

Examiner

Nghii H. Ly

Art Unit

2683

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 March 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-15,17-25 and 27-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-15,17-25 and 27-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Claims 3,16 and 26 have been cancelled.

Claim 29 has been added.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claim 29 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Regarding claim 29 (newly added), the claim recites "The cordless telephone according to claim 1, wherein: said switch is based on receipt of a trigger signal from the base unit of the cordless telephone."

Therefore, the above emphasized limitation was not described in the specification at the time the invention was filed.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made

to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims 1, 2, 4-11, 13-15, 17-21, 23-25, 27 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Benedetto et al (4,591,661) in view of the Applicant's admitted prior art.

Regarding claims 1, 4 and 5, Benedetto teaches a cordless telephone (see abstract), comprising: a remote handset (see fig.2 number 11), a base unit matched to the remote handset (see column 2 lines 18-20) and the remote handset can switch between performing as a telephony device and performing as audio player (see abstract).

Benedetto does not specifically disclose an MPEG audio player. The Applicant's admitted prior art teaches an MPEG audio player (see the Applicant's Detailed Description of Illustrative Embodiments page 4 lines 9-13). Therefore, it would have

been obvious to one of ordinary skill in the art at the time the invention was made to provide the teaching of the Applicant's admitted prior art into the system of Benedetto in order to modernize the system of Benedetto.

Regarding claim 2, the combination of Benedetto and the Applicant's admitted prior art further teaches the MPEG audio player (see the Applicant's Detailed Description of Illustrative Embodiments page 4 lines 9-13) is integrated within the remote handset (see Benedetto number 11).

Regarding claims 6, 7, 17, 18, and 27, Benedetto teaches a cordless phone (see abstract) comprising: connecting a base unit of the cordless telephone to a public switch telephone network (PSTN) (see column 2 lines 18-20, in order to have a conversation between two parties, the base unit of the cordless telephone of Benedetto must inherently connect to a PSTN). Benedetto does not specifically disclose an MPEG audio player and playing pre-loaded MP3. The Applicant's admitted prior art teaches an MPEG audio player and playing pre-loaded MP3 music (see the Applicant's Detailed Description of Illustrative Embodiments page 4 lines 9-13). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teaching of the Applicant's admitted prior art into the system of Benedetto in order to modernize the system of Benedetto.

Regarding claim 8, Benedetto further teaches the music is played substantially real-time as it is received by the cordless telephone (see abstract).

Regarding claims 9, 10, 19 and 20, the combination of the Benedetto and Applicant's admitted prior art further teaches muting (see Benedetto abstract) the

playing of the pre-loaded MP3 music when the remote handset is active in a current telephone call (see the Applicant's Detailed Description of Illustrative Embodiments page 4 lines 9-13).

Regarding claims 11 and 21, the combination of the Benedetto and Applicant's admitted prior art further teaches downloading digital bit stream music comprised in an MPEG format to the remote handset directly from a remote bit stream audio source (see the Applicant's Detailed Description of Illustrative Embodiments page 4 lines 9-13).

Regarding claims 13 and 23, the combination of the Benedetto and Applicant's admitted prior art further teaches the method of integrating an MPEG audio player in a cordless telephone comprising: storing the downloaded digital bit stream music comprised in an MPEG format in the remote handset of the cordless telephone (see the Applicant's Detailed Description of Illustrative Embodiments page 4 lines 9-13).

Regarding claims 14 and 24, the combination of the Benedetto and Applicant's admitted prior art further teaches the method of integrating an MPEG audio player in a cordless telephone wherein: the downloaded digital bit, stream music comprised in an MPEG format is stored in Flash memory in the remote handset (see the Applicant's Detailed Description of Illustrative Embodiments page 4 lines 9-13).

Regarding claims 15 and 25, the combination of the Benedetto and Applicant's admitted prior art further teaches the method of integrating an MPEG audio player (see the Applicant's Detailed Description of Illustrative Embodiments page 4 lines 9-13).

The combination of the Benedetto and Applicant's admitted prior art does not specifically disclose the remote bit stream audio source is accessible by the remote

handset via an Internet. The Examiner takes Official notice such feature recited in the claim is known in the art. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the above conventional teaching into the system of Benedetto and the Applicant's admitted prior art so that audio signal could be transmitted with minimum error.

Regarding claim 28, the combination of the Benedetto and Applicant's admitted prior art further teaches decompressing MPEG formatted music into digital music samples for digital to analog output (see the Applicant's Detailed Description of Illustrative Embodiments page 4 lines 9-13).

6. Claims 12 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Benedetto et al (4,591,661) in view of the Applicant's admitted prior art and further in view of Bartlett (US 5,519,762).

Regarding claims 12 and 22, the combination of the Benedetto and Applicant's admitted prior art teaches the method of integrating an MPEG audio player in a cordless telephone (see Benedetto fig.2 number 11) and downloading digital bit stream music comprised in an MPEG format in a base unit of the cordless telephone (see the Applicant's Detailed Description of Illustrative Embodiments page 4 lines 9-13). The combination of the Benedetto and Applicant's admitted prior art does not specifically disclose storing the bit stream in a base unit of the cordless telephone. Bartlett teaches storing the bit stream in a base unit of the cordless telephone (see column 10 lines 1-11). Therefore, it would have been obvious to one of ordinary skill in the art at the time

the invention was made to provide the teaching of Bartlett into the system of the combination of the Benedetto and Applicant's admitted prior art in order to compress, transmit, receive, and decompress video data without appreciable loss.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

3. Claims 1, 2, 4-11, 13-15, 17-21, 23-25, 27 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Villa-Real (4,481,382) in view of the Applicant's admitted prior art.

Regarding claims 1, 4 and 5, Villa-Real teaches a cordless telephone (see abstract), comprising: a remote handset (see fig.1), a base unit matched to the remote handset (see column 13 lines 14-18) and the remote handset can switch between performing as a telephony device and performing as audio player (see column 4 lines 38-44).

Villa-Real does not specifically disclose an MPEG audio player. The Applicant's admitted prior art teaches an MPEG audio player (see the Applicant's Detailed Description of Illustrative Embodiments page 4 lines 9-13). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teaching of the Applicant's admitted prior art into the system of Villa-Real in order to modernize the system of Villa-Real.

Regarding claim 2, the combination of Villa-Real and the Applicant's admitted prior art further teaches the MPEG audio player (see the Applicant's Detailed Description of Illustrative Embodiments page 4 lines 9-13) is integrated within the remote handset (see Villa-Real fig.1 handset).

Regarding claims 6, 7, 17, 18, and 27, Villa-Real teaches a cordless phone (see abstract) comprising: connecting a base unit of the cordless telephone to a public switch telephone network (PSTN) (see column 13 lines 14-18, in order to have a conversation between two parties, the base unit of the cordless telephone of Villa-Real must

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inherently connect to a PSTN). Villa-Real does not specifically disclose an MPEG audio player and playing pre-loaded MP3. The Applicant's admitted prior art teaches an MPEG audio player and playing pre-loaded MP3 music (see the Applicant's Detailed Description of Illustrative Embodiments page 4 lines 9-13). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teaching of the Applicant's admitted prior art into the system of Villa-Real in order to modernize the system of Villa-Real.

Regarding claim 8, Villa-Real further teaches the music is played substantially real-time as it is received by the cordless telephone (see fig.3 number 26 AM and FM radio).

Regarding claims 9, 10, 19 and 20, the combination of the Villa-Real and Applicant's admitted prior art further teaches muting (see Villa-Real, column 4 lines 38-44) the playing of the pre-loaded MP3 music when the remote handset is active in a current telephone call (see the Applicant's Detailed Description of Illustrative Embodiments page 4 lines 9-13).

Regarding claims 11 and 21, the combination of the Villa-Real and Applicant's admitted prior art further teaches downloading digital bit stream music comprised in an MPEG format to the remote handset directly from a remote bit stream audio source (see the Applicant's Detailed Description of Illustrative Embodiments page 4 lines 9-13).

Regarding claims 13 and 23, the combination of the Villa-Real and Applicant's admitted prior art further teaches the method of integrating an MPEG audio player in a cordless telephone comprising: storing the downloaded digital bit stream music

comprised in an MPEG format in the remote handset of the cordless telephone (see the Applicant's Detailed Description of Illustrative Embodiments page 4 lines 9-13).

Regarding claims 14 and 24, the combination of the Villa-Real and Applicant's admitted prior art further teaches the method of integrating an MPEG audio player in a cordless telephone wherein: the downloaded digital bit, stream music comprised in an MPEG format is stored in Flash memory in the remote handset (see the Applicant's Detailed Description of Illustrative Embodiments page 4 lines 9-13).

Regarding claims 15 and 25, the combination of the Villa-Real and Applicant's admitted prior art further teaches the method of integrating an MPEG audio player (see the Applicant's Detailed Description of Illustrative Embodiments page 4 lines 9-13).

The combination of the Villa-Real and Applicant's admitted prior art does not specifically disclose the remote bit stream audio source is accessible by the remote handset via an Internet. The Examiner takes Official notice such feature recited in the claim is known in the art. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the above conventional teaching into the system of Villa-Real and the Applicant's admitted prior art so that audio signal could be transmitted with minimum error.

Regarding claim 28, the combination of the Villa-Real and Applicant's admitted prior art further teaches decompressing MPEG formatted music into digital music samples for digital to analog output (see the Applicant's Detailed Description of Illustrative Embodiments page 4 lines 9-13).

4. Claims 12 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Villa-Real (4,481,382) in view of the Applicant's admitted prior art and further in view of Bartlett (US 5,519,762).

Regarding claims 12 and 22, the combination of the Villa-Real and Applicant's admitted prior art teaches the method of integrating an MPEG audio player (see the Applicant's Detailed Description of Illustrative Embodiments page 4 lines 9-13) in a cordless telephone (see Villa-Real, abstract) and downloading digital bit stream music comprised in an MPEG format in a base unit of the cordless telephone (see the Applicant's Detailed Description of Illustrative Embodiments page 4 lines 9-13). The combination of the Villa-Real and Applicant's admitted prior art does not specifically disclose storing the bit stream in a base unit of the cordless telephone. Bartlett teaches storing the bit stream in a base unit of the cordless telephone (see column 10 lines 1-11). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teaching of Bartlett into the system of the combination of the Villa-Real and Applicant's admitted prior art in order to compress, transmit, receive, and decompress video data without appreciable loss.

Response to Arguments

5. Applicant's arguments with respect to claims 1, 2, 4-15, 17-25, 27-28 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nghi H. Ly whose telephone number is (703) 605-5164. The examiner can normally be reached on 8:30 am-5:30 pm Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Trost can be reached on (703) 308-5318. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9314 for regular communications and (703) 872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

Nghi H. Ly



May 29, 2003



WILLIAM TROST
SUPERVISORY PATENT EXAMINER
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